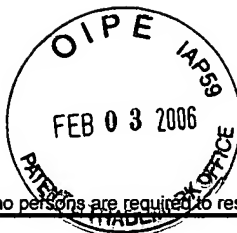


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

PTK-235

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on February 1, 2006

Signature

Typed or printed
name

Linda M. Penta

Application Number

10/729,045

Filed

December 5, 2003

First Named Inventor

Lovenstein

Art Unit

2854

Examiner

Ferguson, Marissa L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

50,773

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Mark L. Beloborodov

Typed or printed name

617-570-1352

Telephone number

February 1, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Attorney Docket No. PTK-235

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Lovenstein *et al.* CONFIRMATION NO.: 9318
SERIAL NO.: 10/729,045 GROUP NO.: 2854
FILING DATE: December 5, 2003 EXAMINER: Ferguson, Marissa L.
TITLE: MAGNETIC PLATE RETENTION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

This paper is submitted, along with a Pre-Appeal Brief Request for Review in accordance with the Official Gazette Notice dated July 12, 2005, and a Notice of Appeal, in response to the Office Action, mailed by the U.S. Patent and Trademark Office on November 2, 2005. A fee for filing of the Notice of Appeal is submitted herewith. Applicants believe that no other fee is required for this submission to be entered. However, please consider this a conditional petition for the proper extension, if one is required, and a conditional authorization to charge any related extension fee, or any other fees, necessary for entry of this submission to Deposit Account No. 07-1700.

Applicants' **Remarks** begin on page 2 of this paper.

REMARKS

The examiner has improperly rejected pending claims 1-10 under 35 U.S.C. § 103(a), as unpatentable over U.S. Patent No. 6,688,227 to Zerillo ("Zerillo") in view of U.S. Patent No. 6,729,235 to Kerr ("Kerr").

To establish a prima facie case of obviousness, every element of the invention as claimed must be found in the prior art. *See In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) and M.P.E.P. §§ 2142, 2143. In the present case, the Examiner has failed to find references which, even when combined, teach the limitations of claims 1 and 6. The Examiner, in other words, has not met even the basic requirements of § 103(a) and thus has not established a prima facie case of obviousness.

Applicants claims 1 and 6 require a retention device having a curved surface complementary to a curvature of the cylinder. Applicants previously pointed out that neither Zerillo nor Kerr teaches a curved retaining surface. The Examiner acknowledged in the final Office Action that neither Kerr nor Zerillo teaches such a surface, yet asserted that one of ordinary skill in the art would be motivated to modify the flat retaining elements of Kerr and then modify Zerillo with the modified teachings of Kerr, and maintained the rejections. However, as noted by Applicants, a curved surface would in fact be detrimental to the performance of Kerr.

Accordingly, even if the cited references were combined as the Examiner proposes, they still would not teach or suggest the requirements of claims 1 and 6. The Examiner's rejection fails to satisfy the requirements of 35 U.S.C. § 103 because Zerillo and Kerr, alone or in combination, do not disclose every element of the claimed invention.

CONCLUSION

Applicants respectfully submit that, in light of the foregoing remarks, the rejections of record are clearly improper. A favorable action is requested.

Respectfully submitted,



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Date: February 1, 2006
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